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EXAMINER

POPHAM, JEFFREY D

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2437

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/575,424	Applicant(s) PENG ET AL.	
	Examiner JEFFREY D. POPHAM	Art Unit 2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20100310</u> . | 6) <input type="checkbox"/> Other: _____ |

Remarks

Claims 17-32 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 3/10/2010 has been entered.

Claim Objections

2. Claim 25 is objected to because of the following informalities: Claim 25 has been amended to state that "the authenticity of the external media content is verified unaware of the authenticity of the one or more computing devices on which the external media content is provided." However, no such computing devices have been discussed in the claim. Therefore, as claim 25 stands, the authenticity of the content is verified "unaware" (described more below in the 112 rejections) of authenticity of devices which have nothing to do with the method. For purposes of prior art rejection, "the one or more computing devices" has been construed as "one or more computing devices". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 17-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to state that "the authenticity of the downloadable media content is verified unaware of the authenticity of the one or more computing devices on which the downloadable media content is provided." The application, as originally filed, does not describe verifying any content "unaware" of the authenticity of a device. In fact, the application as originally filed provides no guidance whatsoever for what "unaware" means in this context. Being "unaware" of authenticity of another entity does not necessarily mean that the other entity is not authenticated by such verification. It could be that verifying authentication could be performed by a piece of program code that is entirely unaware of what it is authenticating, but rather, merely decrypts and verifies a signature, without caring what the data is or what entity signed the data. It could also be that the authenticating code/entity explicitly forbids certain types of data, such as data signed by the devices in claim 1 (e.g. the devices are on a certificate revocation list and, therefore, do not have currently certified signature

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keys), for example. It could also be that the devices are authenticated in the same step, but the authenticating code/entity is unaware of the specific device that is being authenticated, but rather, only has access to a properly signed, non-expired certificate and public key, without a specific name for the device. The above are just examples of what this "unaware" language may be interpreted as, and the application as originally filed provides no discussion or guidance as to how one would go about verifying authenticity of data "unaware of the authenticity of the one or more computing devices", nor does the application as originally filed have basis for any of the examples just provided. All of the other independent claims have this issue and all of the dependent claims have this issue by dependency.

Claim 32 refers to external media content being played "in coordination with the stored media content provided on the optical disk." The specification as originally filed does not have basis for such a limitation. Previously the claims referred to playing a disk in coordination with downloaded content. The application as originally filed uses the word "coordination" 4 times, once in the abstract and 3 times in the claims. Three of the four instances are related to playing the disk in coordination with downloaded content. The final one was original claim 15, which was directed to verifying a playing permission of the optical disk in coordination with network information. As one can see, this is different from the claimed playing of downloadable content in coordination with stored media. It is noted that the claims currently recite playing the stored media content in coordination with downloadable content (such as in claim 17), which

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has basis in the application as originally filed. Playing of the disk (or, perhaps, media stored on the disk) in coordination or cooperation with downloadable contents will result in playing data already stored on the disk, while playing of the downloadable contents in coordination with media stored on the disk is quite the opposite. However, playing downloadable content in coordination with stored media content does not have basis in the application as originally filed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17, 18, 20, 22, 24, 25, 27-29, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kambayashi (U.S. Patent Application Publication 2004/0001697) in view of Uranaka (U.S. Patent 6,470,085)

Regarding Claim 20,

Kambayashi discloses an optical disk player comprising:

An optical disk driver unit to read out stored media content provided on an optical disk (Figures 1 and 18; and Paragraph 47);

A network interface to download one or more external media content, each external media content associated with at least one stored media content, the one or more external media content

provided on one or more computing devices distributed on a network (Figures 1 and 18; and Paragraphs 205, 209, and 212); and

A control system to verify the authenticity of the downloaded external media content using a public key that was obtained before the stored media content is played in coordination with the associated downloaded external media content (Paragraphs 216-221);

Wherein the authenticity of the external media content is verified unaware of the authenticity of the one or more computing devices on which the external media content is provided (Paragraphs 216-221);

But does not appear to explicitly disclose that the public key is read from the optical disk.

Uranaka, however, discloses that the public key is read from the optical disk (Column 6, lines 42-54; Column 7, lines 9-33; Column 8, lines 23-41; and Column 12, lines 12-15). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the content usage control system of Uranaka into the enhanced content reproduction system of Kambayashi in order to ensure that a user has been given an appropriate public key by sending it on the disk along with the

content, and/or to allow the system to restrict content access to those devices that a server deems authorized to do so.

Regarding Claim 17,

Claim 17 is a system claim that is broader than player claim 20 and is rejected for the same reasons.

Regarding Claim 25,

Claim 25 is a method claim that is broader than player claim 20 and is rejected for the same reasons.

Regarding Claim 22,

Kambayashi as modified by Uranaka discloses the player of claim 20, in addition, Kambayashi discloses that the downloaded external media content is an application program (Paragraph 220, script in ENAV contents, for example).

Regarding Claim 29,

Claim 28 is a method claim that is broader than player claim 29 and is rejected for the same reasons.

Regarding Claim 24,

Kambayashi as modified by Uranaka discloses the player of claim 20, in addition, Kambayashi discloses that the control system verifies the authenticity of the downloaded external media content by performing asymmetric cryptography using the public key stored on the optical disk and corresponding to a private key used to

encrypt the downloaded external media content (Paragraphs 216-221).

Regarding Claim 31,

Claim 31 is a method claim that is broader than player claim 24 and is rejected for the same reasons.

Regarding Claim 18,

Kambayashi as modified by Uranaka discloses the system of claim 17, in addition, Uranaka discloses that the public key is stored in a BCA zone of the optical disk (Figures 2 and 4; Column 5, lines 20-42; Column 5, line 58 to Column 6, line 5; and Column 8, lines 34-41).

Regarding Claim 27,

Kambayashi as modified by Uranaka discloses the method of claim 25, in addition, Kambayashi discloses that the coordination between the read out stored media content and the downloaded external media content will not be established if the downloaded external media content is not authenticated (Figure 21; and Paragraph 234).

Regarding Claim 28,

Kambayashi as modified by Uranaka discloses the method of claim 27, in addition, Kambayashi discloses that the coordination between the read out stored media content and downloaded external media content will be established if the downloaded

external media content is authenticated (Figure 21; and Paragraph 234).

Regarding Claim 32,

Kambayashi as modified by Uranaka discloses the method of claim 25, in addition, Kambayashi discloses that the optical disk comprises digital information stored thereon, the stored digital information comprising network address information that is used to download external media content for playing the optical disk (Paragraph 209); and Uranaka discloses that the optical disk comprises a public key that is used to verify the authenticity of the downloaded external media content before playing the external media content in coordination with the stored media content provided on the optical disk (Figures 2 and 4; Column 5, lines 20-42; Column 5, line 58 to Column 6, line 5; and Column 15, lines 57-67).

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kambayashi in view of Uranaka, further in view of Ryan (U.S. Patent 5,754,648).

Kambayashi as modified by Uranaka does not explicitly disclose that the public key is stored in a media content zone of the optical disk.

Ryan, however, discloses that the public key is stored in a media content zone of the optical disk (Column 3, lines 47-67; and Column 8, lines 31-37). It would have been obvious to one of ordinary skill in the art

at the time of applicant's invention to incorporate the media security and tracking system of Ryan into the enhanced content reproduction system of Kambayashi as modified by Uranaka in order to allow the system to provide additional authentication and authorization steps such that a device can ensure that both the disk and device are authentic and authorized for use with each other by using data stored on the optical disk itself and data stored on a magnetic track attached to the disk, thus decreasing the chance of unauthorized use thereof, and/or to provide the ability to track use of the media.

6. Claims 21 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kambayashi in view of Uranaka, further in view of Collins (U.S. Patent Application Publication 2002/0073316).

Regarding Claim 21,

Kambayashi as modified by Uranaka does not explicitly disclose that the control system detects whether the downloaded external media content is integral before verification, wherein the verification will not be executed if the downloaded external media content is detected to not be integral.

Collins, however, discloses that the control system detects whether the downloaded external media content is integral before verification, wherein the verification will not be executed if the downloaded external media content is detected to not be integral

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(Paragraphs 73-77; detecting whether the downloaded content is “integral” may comprise either, or both, verification of the program packet format and/or verification of the checksum, each of which must succeed before signature verification is performed). It would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to incorporate the content authentication and access control system of Collins into the enhanced content reproduction system of Kambayashi as modified by Uranaka in order to allow the system to detect when errors in the data have occurred, such that data with errors will not be allowed to be processed and only correct data will be processed, and/or to ensure that the data is proper and authentic before allowing access to proceed, thereby increasing security of the system by ensuring both integrity and authenticity of the content.

Regarding Claim 26,

Claim 26 is a method claim that is broader than player claim 21 and is rejected for the same reasons.

7. Claims 23 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kambayashi in view of Uranaka, further in view of Tsumagari (U.S. Patent Application Publication 2004/0126095).

Regarding Claim 23,

Kambayashi as modified by Uranaka does not explicitly disclose that the application program is a JAVA language application program.

Tsumagari, however, discloses that the application program is a JAVA language application program (Figure 10; and Paragraphs 143 and 167). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the script execution system of Tsumagari into the enhanced content reproduction system of Kambayashi as modified by Uranaka in order to allow the system to work with various kinds of well-known languages, thereby allowing additional flexibility in the creation of ENAV contents as well as allowing a broader range of devices to take advantage of the ENAV contents.

Regarding Claim 30,

Claim 30 is a method claim that is broader than player claim 23 and is rejected for the same reasons.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY D. POPHAM whose telephone number is (571)272-7215. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571)272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey D Popham
Examiner
Art Unit 2437

/Jeffrey D Popham/
Examiner, Art Unit 2437